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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,001	01/26/2004	Carl Churchill	BIODOT.028C1	6765
20995 7590 04/09/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER ALEXANDER, LYLE				
ART UNIT		PAPER NUMBER		
1797				
NOTIFICATION DATE		DELIVERY MODE		
04/09/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
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Office Action Summary

Application No.

10/765,001

Applicant(s)

CHURCHILL ET AL.

Examiner

Lyle A. Alexander

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 25-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 25-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-10 and 25-38 are rejected under 35 U.S.C. 102(b,) as being clearly anticipated by Tisone(524', 522', 960', 554', 728').

See the appropriate paragraph of the 9/27/07 Office action.

Claims 1-10 and 25-38 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Tisone(295').

See the appropriate paragraph of the 9/27/07 Office action.

Claims 1-10 and 25-38 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Tisone(2002/0001657).

See the appropriate paragraph of the 9/27/07 Office action.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-10 and 25-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tisone(524', 522', 960', 554', 728'), Tisone(295') or Tisone(2002/0001657) .

See the appropriate paragraph of the 9/27/07 Office action.

Response to Arguments

Applicant's arguments filed 1/25/08 have been fully considered but they are not persuasive.

Applicants' remarks were sufficient to overcome the 35 USC 112 first and second paragraph rejections.

The rejections over Deeg et al., Hayes et al. and Brown et al. have been vacated as duplicative of the rejections over Tisone and to the reduce the pending issues.

Applicant concurs the Tisone references teach an arrangement of a "positive displacement pump" and a "dispenser." The Office further states the Tisone references teach a solenoid valve and a programmer controller to control all functions of dispensing and placement of the sample.

Applicant states Tisone fails to teach the claimed limitations as addressed in the 7/23/07 response. The 7/23/07 response states Tisone fails to teach the instant limitations "creating a user-defined text file containing lists of white space delimited number ...". These claimed limitations are very broad in scope and have been interpreted as an interface capable of input from the user defining the parameters of the assay. The Office maintains Tisone teaches a programmable controller which will create files in response to the user's input and is indistinguishable from the pending claims.

Applicants state Tisone fails to teach "... a solenoid valve operated at a frequency such that is ... to facilitated ejection of a predetermined amount of sample"; "text file"; "tab" or "carriage return." The Office maintains Tisone teaches a dispensing device using a solenoid that dispenses precise quantities of sample (e.g. 1-4 nanoliters)

to predetermined locations in a rectangular array. The Office maintains Tisone teaches a method that clearly meets all of the claimed limitations. The programmable controller ejects predetermined amounts of sample and has a file that determines the placement of the sample on the array. The controller is appropriately programmed to provide the "tab" and "carriage returns" movement functions to deposit sample on a rectangular array.

In the 1/25/08 response, Applicant argues Tisone does not teach dispensing in a predetermined pattern by accessing "text files." The claimed "text files" are sufficiently broad to have been properly read on the programmed controller taught by Tisone.

Again in the 1/25/08 response, challenges the position that "it would have been within the skill of the art to use an off the shelf program package ..." and conclude the cited prior art fails to use the claimed "text files." The Office maintains it would have been within the skill of the art to use an off the shelf program and the claimed "text files" are sufficiently broad to have been properly read on the programmed controller taught by Tisone.

The Office appreciates Applicant's disclosure of co-pending applications. Applicant is requested to update the Office when any of these applications issue to a patent so that potential Obviousness Type Double patenting issues can be considered.

This is a RCE of applicant's earlier Application No. 10/765,001. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL**

even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Tuesday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lyle A Alexander
Primary Examiner
Art Unit 1797

/Lyle A Alexander/
Primary Examiner, Art Unit 1797